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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,851	09/15/2003	Bret R. Marschand	29617/PM478	2125
4743	7590	10/20/2006	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606				OSELE, MARK A
ART UNIT		PAPER NUMBER		
				1734

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/662,851	MARSCHAND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark A. Osele	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 and 32-43 is/are pending in the application.
- 4a) Of the above claim(s) 32-43 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 6, 7, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application 427,870 (Murasaki et al.). Murasaki et al. discloses a transfer tape dispenser comprising a case (Figure 7, casing 6); a supply spool (feed reel 2) rotationally mounted in the case and including a supply of tape (revising tape 1) having an application layer (pressure sensitive transfer film 1a) and a carrier tape (base material 1b); a return spool (take-up reel 7) rotationally mounted in the case and adapted to collect the carrier tape; a substantially rigid applicator tip (pressure head 5) pivotally mounted in the case and disposed in a path of the tape between the supply spool and the return spool, the applicator tip pivoting between a rest position (Fig. 9c) and at least an application position (Fig. 7); and a cushion body (spring S) disposed in the case and adapted to bias the applicator tip to the rest position from the application position (column 16, lines 2-39). Murasaki et al. further discloses that the pivot axis, (X) is parallel to an application edge (5a) of the applicator tip (5).

As to Claim 2, Murasaki et al. discloses a transfer tape dispenser wherein the cushion body (spring S) is a discrete cushion body disposed in the case and adapted to

bias the applicator tip to the rest position from the application position (column 16, lines 27-30).

As to Claim 6, Murasaki et al. discloses a transfer tape dispenser wherein the cushion body (spring S) is independent and separate from the case (casing 6) and the applicator tip (pressure 5) and disposed between the applicator tip and an interior surface of the case.

Regarding claim 7, Murasaki et al. discloses a transfer tape dispenser further comprising a slip clutch (21) adapted to slippably couple the supply spool and the return spool (column 15, lines 29-43).

As to Claim 15, Murasaki et al. discloses a transfer tape dispenser wherein the case (casing 6) includes at least a tape post (Figure 7, unmarked posts extending from the interior of the case and contacting the tape) adapted to guide the tape from the supply spool to the applicator tip and from the applicator tip to the return spool.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.) in view of Vulpitta et al. (US 6,681,830).

As to claim 3 Murasaki et al. does not disclose a transfer tape dispenser wherein the cushion body is co-molded with the applicator tip. It is well known and conventional in the apparatus art, as disclosed by Vulpitta et al. (column 4, line 66 through column 5, line 6), to integrally mold the inner structural elements of an apparatus as a matter of engineering choice to minimize the number of parts needed to assemble the apparatus. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the cushion body and the applicator tip of Murasaki et al. to be co-molded as suggested by Vulpitta et al. to minimize the number of parts needed to assemble the apparatus.

As to claim 16, Murasaki et al. does not disclose a transfer tape dispenser wherein an exterior of the case includes a plurality of grip pads. Vulpitta et al. discloses a transfer tape dispenser wherein an exterior of the case (Figure 6, housing 12) include a plurality of grip pads (Figure 6, grip ribs 48) which provide the dispenser with ergonomic shaping for a user's hand (column 4, lines 26-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the case of Murasaki et al. to include a plurality of grip pads as suggested by Vulpitta et al. to provide the dispenser with ergonomic shaping for a user's hand.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.). As shown in paragraph 2 above, Murasaki et al. clearly discloses most of the instantly claimed limitations.

Regarding claim 4, Murasaki et al. discloses the applicator head to be an elastic material (column 17, lines 2-4) while springs are conventionally metal and applicator cases are conventionally hard plastic. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cushion body of a different material than the applicator tip material and case material because the three elements are, conventionally, different materials.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.) in view of Goodwin et al. (US 5,009, 739). Murasaki et al. fails to show the cushion body to be made from an elastomer.

Goodwin et al. discloses a dispenser wherein a cushion body is constructed from a resilient elastomeric material to provide limited movement for an inner structural element (column 9, lines 22-24, 32-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to construct the cushion body of Murasaki et al. from a resilient elastomeric material as suggested by Goodwin et al. to provide controlled movement of the applicator tip.

7. Claims 7-10, 18-19, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.) in view of WIPO Publication WO 01/62648 (Huthmacher). As shown in paragraph 2 above, Murasaki et al. discloses the majority of the instantly claimed limitations, but fails to

show guides on the applicator tip and the supply spool and return spool disposed on the same drive wheel.

Regarding claims 7 and 9-10, Huthmacher discloses a transfer tape dispenser which includes a slip clutch adapted to slippably couple the supply spool (Figure 2, supply spool 11) and the return spool (Figure 2, take-up spool 13) are disposed on the drive wheel (Figure 2, drive connection 26). Furthermore, Huthmacher includes a slip clutch adapted to slippably couple the supply spool and the return spool, wherein the slip clutch is adapted to slippably couple the supply spool to the drive wheel (page 8, lines 2-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the slippably coupled supply spool and return spool of Murasaki et al. with the slippable coupling of a supply spool and return spool as shown by Huthmacher because they are shown to be functionally equivalent, alternate expedients in a transfer tape dispenser.

As to claims 8 and 22, Huthmacher discloses a transfer tape dispenser wherein the applicator tip (Figure 1, application member 8) includes an application edge (Figure 1, spatula 8d) and a plurality of guides (Figure 7, lateral guiding webs 17), wherein the plurality of guides are adapted to guide the tape to and from the application edge (Page 6, line 23 to page 7, line 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the guides of Huthmacher to the applicator tip of Murasaki et al. because Huthmacher shows that guides maintain the transfer tape aligned across the entirety of the applicator edge.

Regarding claim 18, Huthmacher further shows the slip clutch to comprise a plurality of projections adapted to transfer rotation of the drive wheel to the supply spool and to provide slippable rotation of the supply spool relative to the rotation of the return spool (page 8, lines 12-13).

As to Claim 25, Muraski et al. discloses a transfer tape dispenser wherein the case (casing 6) includes at least a tape post (Figure 7, unmarked posts extending from the interior of the case and contacting the tape) adapted to guide the tape from the supply spool to the applicator tip and from the applicator tip to the return spool.

As to Claim 27, Muraski et al. discloses a transfer tape dispenser wherein the cushion body (spring S) is independent and separate from the case (casing 6) and the applicator tip (pressure 5) and disposed between the applicator tip and an interior surface of the case.

8. Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.) in view of Huthmacher (WO 01/62648) as applied to claims 9 and 18 above, and further in view of Huthmacher et al. (US 6,796,355). Huthmacher is silent as to a transfer tape dispenser wherein the return spool is integral with the drive wheel. Huthmacher et al. discloses a transfer tape dispenser wherein the return spool (Figure 3, take-up reel 5) is integral with the drive wheel (Figure 3, gear arrangement 27). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the drive wheel of the references as combined above to be integral with the return spool as suggested by Huthmacher et al.

to yield a dispenser which includes a minimal number of parts, thereby reducing assemble time for the dispenser.

9. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.) in view of Huthmacher (WO 01/62648) as applied to claims 9 and 18 above, and further in view of Hsu (US 6,453,968). The references as combined do not disclose a transfer tape dispenser wherein the drive wheel includes a plurality of tabs radially disposed thereon and adapted to engage a plurality of detents radially disposed on an interior of the case to prevent the wheel from rotating in a non-dispensing direction. It is well known and conventional in the dispensing apparatus art, as disclosed by Hsu (Figure 3, casing 1, driving reel 22, ratchet ring 23; column 2, lines 18-22), to provide a drive wheel with a plurality of tabs radially disposed thereon and adapted to engage a plurality of detents radially disposed on an interior of the case to prevent the drive wheel from rotating in a non-dispensing direction. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the transfer tape dispenser of the references as combined above to include a drive wheel having a plurality of tabs radially disposed thereon and adapted to engage a plurality of detents radially disposed on an interior of the case as suggested by Hsu to prevent the wheel from rotating in a non-dispensing direction.

10. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.) in view of Huthmacher (WO 01/62648) as applied to claims 9 and 18 above, and further in view of Manusch et al. (US 6,079,660). Huthmacher discloses a transfer tape dispenser wherein the slip clutch frictionally engages both the supply spool and the return spool to limit tensile stress on the carrier tape (page 8, lines 2-13), but is silent as to the inner structural elements of the slip clutch. Manusch et al. discloses a transfer tape dispenser wherein the slip clutch (Figure 1, slipping clutch 16) includes a plurality of arcuate shoes (Figure 1, support shoes 18) coupled to a hub (Figure 1, spindle 15) projecting from the drive wheel, and wherein the plurality of arcuate shoes frictionally engage an internal periphery of the return spool (Figure 1, take-up spool core 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the slip clutch of the references as combined with inner structural elements, i.e. a plurality of arcuate shoes coupled to a hub projecting from the drive wheel, as suggested by Manusch et al. to enable the slipping clutch to frictionally engage an internal periphery of both the supply spool and the return spool and thereby control the tensile stress on the carrier tape.

As to Claim 14, the references as combined (see Manusch et al.) disclose a transfer tape dispenser wherein each arcuate shoe includes ridges (Figure 1, stops 20) projecting from an outer surface thereof, and wherein the ridges frictionally engage the internal periphery of both the supply spool and the take-up spool.

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11. Claims 17, 21, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.) in view of Huthmacher (WO 01/62648) as applied to claims 9 and 18 above, and further in view of You (US 2004/0033353). The references as combined do not disclose a transfer tape dispenser which includes an applicator tip protector pivotally attached to an exterior of the case and adapted to pivot between an open position wherein the applicator tip is uncovered and a closed position wherein the applicator tip is covered. You discloses a transfer tape dispenser which includes an applicator tip protector pivotally attached to an exterior of the case and adapted to pivot between an open position wherein the applicator tip is uncovered and a closed position wherein the applicator tip is covered (Figures 1 and 2, protective cap 200). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the transfer tape dispenser of the references as combined to include an applicator tip protector as suggested by You to provide protection for the applicator tip and the transfer tape during storage.

Regarding claim 21, Murasaki et al. discloses the applicator head to be an elastic material (column 17, lines 2-4) while springs are conventionally metal and applicator cases are conventionally hard plastic. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cushion body of a different material than the applicator tip material and case material because the three elements are, conventionally, different materials.

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12. Claims 20, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.) in view of Huthmacher (WO 01/62648) as applied to claims 9 and 18 above, and further in view of Vulpitta et al. (US 6,681,830).

As to claim 20, the references as combined do not disclose a transfer tape dispenser wherein the cushion body is co-molded with the applicator tip. It is well known and conventional in the apparatus art, as disclosed by Vulpitta et al. (column 4, line 66 through column 5, line 6), to integrally mold the inner structural elements of an apparatus as a matter of engineering choice to minimize the number of parts needed to assemble the apparatus. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the cushion body and the applicator tip of the references as combined to be co-molded as suggested by Vulpitta et al. to minimize the number of parts needed to assemble the apparatus.

As to claim 28, the references as combined do not disclose a transfer tape dispenser wherein an exterior of the case includes a plurality of grip pads. Vulpitta et al. discloses a transfer tape dispenser wherein an exterior of the case (Figure 6, housing 12) include a plurality of grip pads (Figure 6, grip ribs 48) which provide the dispenser with ergonomic shaping for a user's hand (column 4, lines 26-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the case of the references as combined to include a plurality of grip pads as suggested by Vulpitta et al. to provide the dispenser with ergonomic shaping for a user's hand.

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13. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 427,870 (Murasaki et al.) in view of Huthmacher (WO 01/62648) as applied to claims 9 and 18 above, and further in view of Goodwin et al. (US 5,009, 739). The references as combined fail to show the cushion body to be made from an elastomer.

Goodwin et al. discloses a dispenser wherein a cushion body is constructed from a resilient elastomeric material to provide limited movement for an inner structural element (column 9, lines 22-24, 32-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to construct the cushion body of the references as combined from a resilient elastomeric material as suggested by Goodwin et al. to provide controlled movement of the applicator tip.

***Election/Restrictions***

14. Applicant's election with traverse of Group I in the reply filed on April 14, 2006 is acknowledged. The traversal is on the ground(s) that there is no burden on the Patent Office to examine all claims. This is not found persuasive because the factors involved in deciding burden on the Patent Office includes more than just the field of search. An important factor is the time and effort expended by the examiner to review all relevant prior art to determine if claims are allowable. In the instant application, the effort to review the prior art and formulate a rejection would create a burden on the Patent Office.

The requirement is still deemed proper and is therefore made FINAL.

15. This application contains claims drawn to an invention nonelected with traverse in Paper filed April 14, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Response to Arguments***

17. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MARK A. OSELE

PRIMARY EXAMINER

October 16, 2006